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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,519	04/26/2000	Peter V. Boesen M.D.	P04179US0	9687
22885	7590	08/24/2004	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			KALINOWSKI, ALEXANDER G	
		ART UNIT	PAPER NUMBER	
		3626		

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/558,519	BOESEN M.D., PETER V. <i>MW</i>	
	<b>Examiner</b>	<b>Art Unit</b>	3626
	Alexander Kalinowski		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 May 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 84-89, 92 and 93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 84-89, 92 and 93 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 84-89 and 92-93 are presented for examination. Applicant filed an amendment on 5/26/2004, canceling claims 90-91 and adding new claims 92-93. after careful consideration of Applicant's amendments and arguments, the examiner finds Applicant's arguments to be non-persuasive. The Examiner maintains the rejection of claims 84-89 based on 35 USC 102 and 35 USC 103. New grounds of rejection are established for new claims 92-93. Therefore, the rejection of claims 84-89 and 92-93 is a final rejection of the claims.

***Response to Arguments***

2. Applicant's arguments filed on 5/26/2004 have been fully considered but they are not persuasive. Applicant argues that Waters does not explicitly disclose "linking the patient procedure code to the at least one diagnosis code on the first computer at the point of service". The Examiner disagrees. Waters specifically discloses that "Medicare billing is based on two sets of codes: the diagnosis code and the procedure code. The diagnosis code represents the diagnosed illness or malady or in some cases just the fact that the patient is having a routine checkup. The procedure code represents the procedure being ordered and is associated with the diagnosis code on the basis of medical necessity. In other words, each diagnosis code has a set of related procedures that can be ordered and will, barring any other mitigating circumstances, be reimbursed by

Art Unit: 3626

Medicare." (col. 1, lines 13-40). Therefore, Waters discloses that patient procedure codes are associated with diagnosis codes. Furthermore, the Examiner notes that canceled dependent claims 90-91 (dependent on base claims 84 and 88) used the "associated" claim language to further limit the base claims. Waters discloses linking the patient procedure code to the at least one diagnosis code at the point of service computer. Therefore, Applicant's arguments are non persuasive.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 84, 88 and 89 are rejected under 35 U.S.C. 102(e) as being anticipated by Waters et al., Pat No. 6,393,404 (hereinafter Waters).

As to claim 84, Waters discloses A method for providing point of service medical reporting, comprising:  
receiving a selection of a patient procedure code from a care provider on a first computer at a point of service (col. 3, lines 43-52);

Art Unit: 3626

receiving a selection of at least one diagnosis code from the care provider on the first computer at the point of service (col. 3, lines 53-65);

linking the patient procedure code to the at least one diagnosis code on the first computer at the point of service (col. 3, lines 53-65).

As to claim 88, Waters discloses The method of claim 84 further comprising associating the patient procedure code and the at least one diagnosis code with patient data including patient identifying information (col. 4, lines 2-8).

As to claim 89, Waters discloses The method of claim 84 further comprising sending patient data, including patient identifying information to the first computer from a second computer prior to the steps of receiving a selection of a patient procedure code and receiving a selection of a diagnosis code (col. 4, lines 2-8).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 92 is rejected under 35 U.S.C. 102(b) as being anticipated by Guadagnino, Christopher, "Documentation and coding tools" (hereinafter Guadagnino).

As to Claim 92 , Guadagnino discloses A method for providing code-driven point of service medical reporting (i.e. CodeMaster express)(pages 4-5), comprising: .

receiving a selection of a patient procedure code from a care provider on a first computer at a point of services (pages 4-5);

receiving a selection of at least one diagnosis code from the care provider on the first computer at the point of service (pages 4-5);

linking the patient procedure code to the at least one diagnosis code on the first computer at the point of service such that a record of a care provider defined relationship between the at least one diagnosis code is maintained (pages 4-5).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters as applied to claim 84 above, and further in view of Lavin et al, Pat. No. 5,772,585 (hereinafter Lavin).

As to claim 85, Waters does not explicitly disclose The method of claim 84 further comprising electronically sending patient data including the patient procedure code and the at least one diagnosis code from the first computer to a second computer.

However, Lavin discloses electronically sending patient data including the patient procedure code and the at least one diagnosis code from the first computer to a second

Art Unit: 3626

computer (col. 8, line 59 – col. 9, line 8, and lines 35-57). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include electronically sending patient data including the patient procedure code and the at least one diagnosis code from the first computer to a second computer as disclosed by Lavin within Waters for the motivation of providing a comprehensive method of managing clinical medical information using a common user interface to access centralized files and recording patient examination data through convenient methods (col. 1, lines 53-62 and col. 3, lines 1-11).

As to claim 86, Water discloses the method of claim 85 further comprising displaying the patient procedure code and the at least one diagnosis code on a display of the first computer prior to the step of electronically sending (see Fig. 2 and Fig. 3).

As to claim 87, Waters does not explicitly disclose the method of claim 85 further comprising generating a patient bill at the second computer, the patient bill associated with the patient data.

However, Lavin discloses generating a patient bill at the second computer, the patient bill associated with the patient data (col. 9, lines 38-40 and col. 13, lines 56-59). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include generating a patient bill at the second computer, the patient bill associated with the patient data as disclosed by Lavin within Waters for the motivation of providing a comprehensive method of managing clinical medical information using a

common user interface to access centralized files and recording patient examination data through convenient methods (col. 1, lines 53-62 and col. 3, lines 1-11).

9. Claim 93 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guadagnino as applied to claim 92 above, and further in view of Lavin.

As to Claim 93, Guadagnino does not explicitly disclose The method of claim 92 further comprising generating a bill based on the patient procedure code and the at least one diagnosis code.

However, Lavin discloses generating a bill based on the patient procedure code and the at least one diagnosis code (col. 13, lines 8-43). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Lavin within Guadagnino for the motivation of quickly producing a bill for services rendered (col. 13, lines 8-43).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pub. No. 2002/0087533 discloses a system for ascertaining an ICD or CPT code associated with an ailment.

Art Unit: 3626

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Art Unit: 3626

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

Art Unit 3626

8/20/04